

# 15

CERTIFICATE OF EXPRESS MAILING

Express Mail Mailing Label No. EV 312852732 US  
Date of Deposit: October 24, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 24, 2003

By: Barbara Bryant  
Barbara Bryant

PATENT  
Attorney's Docket No. P-088-R  
Customer No. 27038

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
	)	
M. R. Leadbetter et al.	)	Group Art Unit: 1654
	)	
Patent No. 6,635,618 B2	)	Examiner: Jeffrey E. Russel
Issued: October 21, 2003	)	
	)	Confirmation No. 5218
Application No.: 09/847,042	)	
Filed: May 1, 2001	)	
	)	
For: GLYCOPEPTIDE PHOSPHONATE	)	
DERIVATIVES	)	

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**INDICATED ON ISSUED PATENT (37 C.F.R. § 1.705)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**  
**OCT 29 2003**  
**OFFICE OF PETITIONS**

Sir:

Applicants respectfully request reconsideration of the patent term adjustment indicated on United States Patent No. 6,635,618 B2, issued on October 21, 2003, pursuant to 35 U.S.C. §154(b) and 37 C.F.R. §1.702. This paper is being filed on or before November 20, 2003, i.e., within thirty days of the date the above-identified patent issued.

10/28/2003 SLUANG2 00000004 500344 6635618

01 FC:1455 200.00 DA

1. Statement of Facts

Pursuant to 37 C.F.R. §1.705(b)(2), Applicants respectfully submit the following statement of the facts involved:

A. 37 C.F.R. § 1.705(b)(2)(i) and (ii)

The patent term adjustment shown on U.S. Patent No. 6,635,618 B2 is 88 days. Applicants respectfully submit that the correct patent term adjustment is 144 days. The basis on which Applicants seek adjustment is as follows:

(a) Period of Adjustment Pursuant to 37 C.F.R. §1.703(a)(1)

Applicants are entitled to 107 days of patent term adjustment pursuant to 37 C.F.R. § 1.703(a)(1) as determined in the Decision on Application for Patent Term Adjustment, mailed on September 5, 2003 (copy attached). This Decision was rendered in response to the Request for Reconsideration of Patent Term Adjustment filed by Applicants on May 7, 2003, which requested that the PTO reconsider the erroneous assignment of 51 days of patent term adjustment shown on the Notice of Allowance for this application.

(b) Period of Adjustment Pursuant to 37 C.F.R. §1.703(a)(6)

Applicants are also entitled to 37 days of patent term adjustment pursuant to 37 C.F.R. § 1.703(a)(6). Specifically, the issue fee was paid and all outstanding requirements were satisfied for this application on May 14, 2003. The resulting patent issued on October 21, 2003, which is 37 days after the day that is four months after the date the issue fee was paid. This period was determined correctly by the PTO.

However, in determining the patent term adjustment indicated on the issued patent, the PTO incorrectly added the 37 days under 37 C.F.R. § 1.703(a)(6) to the erroneous 51 days under 37 C.F.R. § 1.703(a)(1) to arrive at 88 days of patent term adjustment. Instead, the PTO should have added the 37 days under 37 C.F.R. § 1.703(a)(6) to the correct 107 days under 37 C.F.R. § 1.703(a)(1) to arrive at 144 days of patent term adjustment.

B. 37 C.F.R. §1.705(b)(2)(iii)

This patent is not subject to a terminal disclaimer.

C. 37 C.F.R. §1.705(b)(2)(iv)

Applicants are not aware of any circumstances during the prosecution of this application that constitute a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. §1.704.

D. Summary

In summary, U.S. Patent No. 6,635,618 B2 is entitled to a period of patent term of adjustment under 35 U.S.C. § 154(b) of 144 days (i.e., 107 days + 37 days). Therefore, Applicants respectfully request that this petition be granted and that this application be forwarded to the Office of Patent Publication for prompt issuance of a Certificate of Correction.

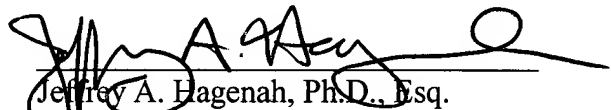
2. Fee Pursuant to 37 C.F.R. §1.18(e)

Pursuant to 37 C.F.R. §1.705(b)(1), a Fee Transmittal is enclosed authorizing the Commissioner to charge the Petition fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) to deposit account 50-0344. The Commissioner is also authorized to charge any additional fees or credit any overpayment to this deposit account. The Fee Transmittal is submitted in duplicate.

Should there be any questions concerning this paper, please contact the undersigned attorney at (650) 808-6406.

Respectfully submitted,

Date: October 24, 2003

  
Jeffrey A. Hagenah, Ph.D., Esq.  
Reg. No. 35,175

THERAVANCE, INC.  
901 Gateway Boulevard  
South San Francisco, CA 94080  
Tel: (650) 808-6000 Fax: (650) 808-6078

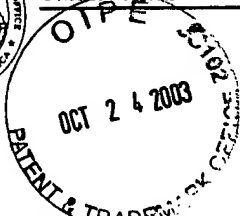
**RECEIVED**

OCT 29 2003

OFFICE OF PETITIONS



## UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Patent Department  
SEP 09 2003

Paper No. 14

THERAVANCE, INC.  
901 GATEWAY BOULEVARD  
SOUTH SAN FRANCISCO, CA 94080

COPY MAILED

SEP 05 2003

OFFICE OF PETITIONS

COPY

In re Application  
Leadbetter et al  
Application No. 09/847,042  
Filed: May 1, 2001  
Attorney Docket No. P-088-R

:  
:  
: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT  
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR § 1.705)" filed May 7, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from fifty-one (51) days to one hundred five (105) days.

The application for patent term adjustment is GRANTED to the extent indicated herein. The adjustment has been corrected to one hundred seven (107) days (rather than the requested one hundred five days).

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance was one hundred seven (107) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 24, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 51 days. Applicants timely<sup>1</sup> submitted the instant application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was one hundred five (105) days. Applicants state that a reply to the Office action mailed October 16, 2002 was timely filed by facsimile transmission on January 15, 2003. However, the response was not entered by the Office. Applicant, on February 11, 2003 and again on March 6, 2003, submitted duplicate copies of the reply. The Office entered the reply on March 11, 2003, and using the March 11, 2003 date, reduced the patent term adjustment by 54 days. In support thereof, applicants submit a copy of their unit's report confirming transmission of the reply on January 15, 2003 (as well as, copies of the reports for the duplicates sent February 11, 2003 and March 6, 2003).

<sup>1</sup> PALM records indicate that the Issue Fee payment was received in the Office on May 14, 2003.

RECEIVED

OCT 29 2003

OFFICE OF PETITIONS

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer and that there were no circumstances in the prosecution of the application which constituted failure to engage in reasonable efforts to conclude processing or examination (other than a 2 day delay in filing the response to a Notice to File Missing Parts mailed July 2, 2001).

The Office initially determined a patent term adjustment of fifty-one (51) days based on an adjustment for PTO delay of one hundred seven (107) days pursuant to 37 CFR 1.703(a)(1) reduced by a total of fifty (56) days pursuant to 37 CFR 1.704(b) for applicants' delay of two (2) days in replying to the Notice to File Missing Parts of Application mailed July 2, 2001, and of fifty-four (54) days in replying to the non-final Office action mailed October 16, 2002. Applicants neither contest the calculation of Office delay or the reduction of two (2) days.

A review of the application history reveals that the calculation of Office delay is correct<sup>2</sup>; however, both calculations of applicant delay are incorrect.

Applicants' arguments as to the timely filing of the response to the non-final Office action are well-taken. Applicants' evidence is consistent with that required under 37 CFR 1.8(b) to show timely filing by facsimile transmission. In fact, the record supports a conclusion that the amendment, resubmitted on March 11, 2003, was accepted as timely filed on January 15, 2003 pursuant to 37 CFR 1.8(b). Ordinarily, the benefit of a certificate of mailing or transmission is not considered in calculating patent term adjustment. See § 1.704(f). However, under the circumstances, the January 15, 2003 date should have been used for the date of response in the PALM system and in calculating any patent term adjustment. Thus, the filing of the reply to the non-final Office action occurred within three months of the mail date of the Office action, and did not constitute a failure to engage in reasonable efforts to conclude prosecution or examination within the meaning of § 1.704(b). Accordingly, applicants should not have been assessed a fifty-four (54) day reduction of patent term adjustment.

Likewise, a review of the record reveals that applicants did not delay in filing a reply to the Notice to File Missing Parts of Application mailed July 2, 2001. A complete and proper reply was filed on August 6, 2001, not October 4, 2001. As this was within three months of the mail date of the Notice, this filing also did not constitute a failure to engage in reasonable efforts to conclude prosecution or examination within the meaning of § 1.704(b). Accordingly, applicants should not have been assessed a further two (2) day reduction of patent term adjustment.

---

<sup>2</sup> The Office first mailed an action under 35 U.S.C. 132 on October 16, 2002, fourteen months and 107 days after the filing date of the application on May 1, 2001 (beginning July 2, 2002 and ending October 16, 2002).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one hundred seven (107) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued in a timely manner.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.



Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

**RECEIVED**

OCT 29 2003

OFFICE OF PETITIONS

10-27-03

PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☐

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Application Number 09/847,042, now U.S. 6,635,618

Filing Date May 1, 2001

First Named Inventor M. R. Leadbetter et al.

Group Art Unit 1654

Examiner Name Jeffrey E. Russel

Total Number of Pages in This Submission

10

Attorney Docket Number

P-088-R

**ENCLOSURES (check all that apply)**

☒ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Response

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/  
Incomplete Application

☐ Response to Missing  
Parts under 37 CFR  
1.52 or 1.53

☐ Assignment Papers  
(for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☒ Petition (3 pages)\*

☐ Petition to Convert to a  
Provisional Application

☐ Power of Attorney, Revocation  
Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) \_\_\_\_\_

☐ After Allowance Communication to  
Group

☐ Appeal Communication to Board of  
Appeals and Interferences

☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s)  
(please identify below):

Postcard

Remarks

\*Included in this application (petition) for patent term adjustment are the following: Petition (3 pages); copy of Decision on Application for Patent Term Adjustment (4 pages); Fee Transmittal (1 page in duplicate = 2 pages); and this Transmittal Sheet (1 page).

Total Pages = 10.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm  
or  
Individual name

Jeffrey A. Hagenah, Reg. No. 35,175

Signature

Date

October 24, 2003

**RECEIVED**

OCT 29 2003

OFFICE OF PETITIONS

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 (Express Mail Label No. EV 312852732 US) and is addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Washington, D.C. 20231 on: October 24, 2003.

Typed or printed name

Barbara Bryant

Signature

Barbara Bryant

Date

October 24, 2003

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, O. Box 1450, Alexandria, VA 22313-1450.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Approved for use through 07/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 200

## Complete If Known

Application Number	09/847,042, now U.S. 6,635,618
Filing Date	May 1, 2001
First Named Inventor	M. R. Leadbetter et al.
Examiner Name	Jeffrey E. Russel
Art Unit	1654
Attorney Docket No.	P-088-R

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit  
Account  
Number

50-0344

Deposit  
Account  
Name

Theravance, Inc.

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$) 0

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		-20 **	=	0	X		=	0
Independent Claims		-3 **	=	0	X		=	0
Multiple Dependent					X		=	0

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2)

(\$) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) Fee for filing an Application for Patent Term Adjustment specified in 1.18(e). Fee Code 1455

200

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$) 200

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type)	Jeffrey A. Hagenah	Registration No. (Attorney/Agent)	35,175	Telephone	(650) 808-6406
Signature				Date	October 24, 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.